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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/582,418

06/09/2006

Robert Egli

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25255

7590

08/13/2009

CLARIANT CORPORATION  
INTELLECTUAL PROPERTY DEPARTMENT  
4000 MONROE ROAD  
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EXAMINER

POWERS, FIONA

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

08/13/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/582,418	<b>Applicant(s)</b> EGLI, ROBERT	
	<b>Examiner</b> Fiona T. Powers	<b>Art Unit</b> 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

Claims 1 to 11 are pending in the application.

***Claim Rejections - 35 USC § 112, Second Paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 to 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, an "or" should be inserted before "bromine" in the definition of R<sub>2</sub>.

In claim 1, in the definition of R<sub>2</sub> the phrase "(\* attached to the nucleus)" is not clear since it is not clear what is the nucleus.

In claim 2, part (a), an "or" should be inserted before the last substituent listed.

In claim 3, line 6, an "or" should be inserted before "2,6-dicyano-4-nitrophenyl" since the preceding groups do not have the "phenyl" group or other group that could be considered a diazo component listed.

Art Unit: 1626

In claim 3, last line, variables  $R'_1$ ,  $R'_2$  and  $R'_4$  are not defined above in the claim or in claim 1 on which claim 3 depends.

In claim 9, an "or" should be inserted before "triacetate".

Claim 11 is indefinite because it refers to "a process according to Claim 1", however, claim 1 is not drawn to a process.

***Claim Rejections - 35 USC § 112, First Paragraph***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

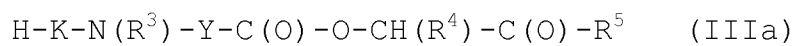
Claims 1 to 11 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a process for the preparation of a dye of the formula (I) comprising the step of coupling a diazotized amine of the formula (II)

D-NH<sub>2</sub> (II)

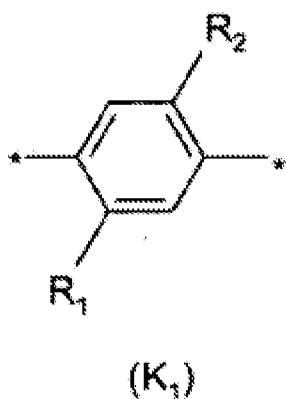
wherein D is a substituted phenyl, thienyl, thiazolyl, isothiazolyl, thiadiazolyl, pyrazolyl, imidazolyl, triazolyl,

Art Unit: 1626

benzothiazolyl or benzoisothiazolyl radical with a compound of the formula (IIIa)



wherein K is an aromatic radical of the formula K<sub>1</sub>



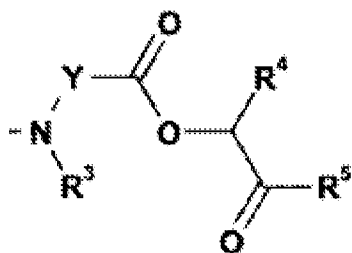
, does not reasonably provide enablement for a process for the preparation of a dye of the formula (I) comprising the step of coupling a diazotized amine of the formula (II)



with a compound of the formula (III)

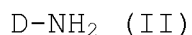
H-K (III). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

The process as set forth in claim 4 does not prepare the dyes of the formula (I) since K is K<sub>1</sub>, K<sub>2</sub> or K<sub>3</sub> as disclosed in claim 1. The portion of the dye molecule that is



would be missing. Page 6, lines 11 to 20 of the specification discloses the same process as in claim 4 and thus does not provide a process for the preparation of the dyes of the formula (I).

Examples 1 to 5 and pages 13 to 18 of the specification only provide a process for the preparation of dyes of the formula (I) comprising the step of coupling a diazotized amine of the formula (II)

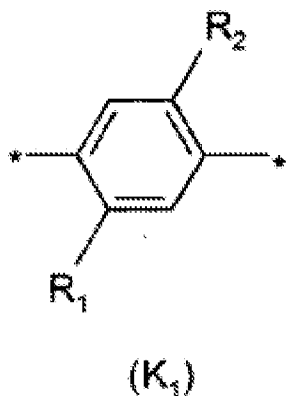


wherein D is a substituted phenyl, thienyl, thiazolyl, isothiazolyl, thiadiazolyl, pyrazolyl, imidazolyl, triazolyl, benzothiazolyl or benzoisothiazolyl radical with a compound of the formula (IIIa)



Art Unit: 1626

wherein K is an aromatic radical of the formula K<sub>1</sub>



### ***Response to Arguments***

Applicant's submission of a certified English translation of the priority document is sufficient to overcome the rejection of the claims under 35 USC 103(a) presented in the previous office action.

### ***Allowable Subject Matter***

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fiona T. Powers whose telephone number is 571-272-0702. The examiner can normally be reached on Monday - Friday 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Fiona T. Powers/  
Primary Examiner, Art Unit  
1626

ftp  
August 12, 2009